

Remarks

Objection to the Specification

Applicants have amended the Specification as suggested by the Examiner; reconsideration of the rejection is respectfully requested.

The Rejection of Claims 1, 2 and 4 under 35 U.S.C. §102

The Examiner rejected Claims 1, 2 and 4 under 35 U.S.C. §102 as being anticipated by U.S. Patent No. 4,284,327 (Kraft et al.) and indicated that Kraft et al. teach a microscope comprising an auxiliary power outlet connected to a power inlet for receiving a power cord of an electrically powered auxiliary apparatus. Applicants respectfully traverse the Examiner's rejection of Claims 1, 2 and 4 and traverse the rejection inasmuch as the new rejection may apply to new Claims 5-8.

A rejection based on anticipation requires that the four corners of a single, prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. *See Atlas Powder Co. v. Ireco, Inc.*, 51 U.S.P.Q.2d 1943, 1947 (Fed. Cir. 1999). Additionally, in order to support finding of anticipation, each and every element of the claim must be literally present as arranged in the claim. *In re Bond*, 15 USQ2d 1566 (CAFC 1990). Kraft et al. do not anticipate the invention of Claims 1, 2 or 4.

First, Kraft et al. do not disclose a microscope comprising an auxiliary power outlet for receiving a power cord of an electrically powered auxiliary device as required by Claim 1, or disclose an auxiliary power outlet formed according to a common standard chosen from a

plurality standards in use throughout the world as required by Claim 2. What Kraft et al. do disclose is a microscope comprising electrical component 16 and electrical and mechanical connectors 6 and 7 for securing an auxiliary lighting housing directly to the surface of a microscope housing. The mechanical and electrical connector devices 6 or 7 disclosed by Kraft et al. comprise flanges specifically configured for securing and supporting the weight of a lighting housing and are not adapted for receiving a power cord. Indeed, connector devices 6 and 7 are specifically adapted to comprise "recesses affecting mechanical locking" for securing the lighting housing means thereto. (See Column 3, lines 54-61). Thus, Kraft et al. do not disclose an externally powered device that is connected to their microscope by means of a power cord. Indeed, the illumination means of the lighting housing of Kraft et al. is powered internally via the electrical component 16 or via an external power cord connected to an external power supply (See Figure 2b); there is no disclosure of an auxiliary device comprising a power cord that connects to the microscope.

Second, while Kraft et al. disclose that electrical component 16 may comprise a plurality of devices such as a power supply plug. (See Column 4, lines 34-43), they do not disclose an auxiliary power outlet, or a standard power outlet. A power supply plug is very different from an outlet and may be plugged into an outlet to provide power. In simplest terms a power supply plug is not capable of receiving a power cord therein, but rather an outlet is.

Third, with specific regard to Claim 2, Kraft et al. do not disclose a microscope having an auxiliary outlet formed according to a common standard used throughout the world, e.g. a 110/120 two or three-pronged outlet/plug, 220/240 three-pronged outlet/plug, etc. Indeed, Kraft et al. disclose an electrical connection specifically designed and adapted for mechanically securing a lighting housing to the microscope.

Finally, with regard to new Claims 5-8, Kraft et al. disclose electrical component 16 as being mounted "on the internal side walls of the base 2 or the stand or on the internal ceiling of the vault of the base 2 of the stand or inside the columnar part of the microscope stand 1." (Column 4, lines 40-44). Kraft et al. do not disclose an auxiliary power outlet adapted to accept a standard International Electrotechnical Commission (IEC) electrical connector and do not disclose an auxiliary power inlet and outlet on an outer surface of a microscope.

Thus, for the reasons set forth above, Applicants respectfully submit that Kraft et al. do not anticipate the invention of Claims 1-8.

The Rejection of Claim 3 under 35 U.S.C. §103

The Examiner also rejected Claim 3 under 35 U.S.C. §103 as being obvious in view of Kraft et al. and U.S. Patent No. 5,389,740 (Austin). Applicant respectfully traverses the rejection.

"Virtually all inventions are combinations of old elements. Therefore, an Examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue." *In re Rouffet*, 47 U.S.P.Q.2d 1 453 (Fed. Cir. 1998).

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. *In re Piasecki*, 223 U.S.P.Q. 785, 787-88 (Fed. Cir. 1984). The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. *In*

re Obukowicz, 27 U.S.P.Q.2d 1063, 1065 (Bd. of Patent Appeals 1993); *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

Additionally, when a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references and the teachings of the references can be combined only if there is some suggestion or incentive to do so. *In Re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002), citing *In re Fine*. The Examiner must explain the reasons one of ordinary skill in the art would have been motivated to select the references and combine them to render the claimed invention obvious. *Id*; *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1998). Moreover, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills* 16 USPQ2d 1430. Thus, the question of motivation to combine references is material to patentability and cannot be resolved on subjective belief and unknown authority. *In Re Lee, supra*. Additionally, deficiencies of the cited references cannot be remedied by general conclusions about what is “basic knowledge,” or “common sense.” *Id*. Indeed, “to imbue one of ordinary skill in the art with knowledge of the invention … when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *Id*; *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303 (Fed. Cir. 1983). Hence, there must be a motivation to choose the references for combination, elements of separate patents cannot be combined when there is no suggestion of such combination in those patents, and a “lofty level of skill alone does not suffice to supply a motivation to combine. Otherwise, a high level of skill in an ordinary art field would almost always preclude patentable inventions.” *In re Rouffet*, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998);

Panduit Corp. v. Dennison Manufacturing Co., 1 U.S.P.Q.2d 1593 (Fed. Cir. 1987). Hence, "there is nothing in the statutes or case law which makes, that which is within the capabilities of one skilled in the art synonymous with obviousness." *Ex Parte Gerlach and Woerner*, 212 U.S.P.Q. 471 (Bd. of Patent Appeals 1980).

In the present case there is no teaching, suggestion or motivation to select Kraft et al. and Austin for combination and neither reference contains any teaching, suggestion or motivation to make the combination propounded by the Examiner to create the subject invention.

As indicated *supra*, Kraft et al. do not even disclose a microscope comprising an auxiliary power outlet capable of accepting a power cord from an auxiliary power device. Indeed, Kraft et al. specifically disclose connectors 6 and 7 comprising flanges for securing and supporting a lighting housing upon the outside of a microscope. Additionally, Austin discloses a safety cover for enclosing a standard power outlet for a wall that is capable of being "flipped" open. Austin does not disclose an auxiliary power outlet for a microscope and does not disclose an auxiliary power outlet cover adapted to be removable by a service technician but not by an end user as required by Claim 3. Finally, Kraft et al. relates to microscopes and Austin relates to wall mounted power outlets. Hence, in view of the above, there is simply no motivation to select the references for combination.

Furthermore, none of the references considered individually and collectively, contain sufficient teaching, suggestion or motivation to make the combination propounded by the Examiner. Kraft et al do not disclose, teach or suggest an auxiliary power outlet connected to a power inlet for receiving a power cord of an electrically powered auxiliary device. Indeed, Kraft et al. specifically disclose connectors 6 and 7 comprising flanges for securing a lighting housing to a microscope and do not disclose a microscope comprising a power outlet for receiving a

power cord of an auxiliary device. Likewise, Austin does not contain a teaching, suggestion or motivation to combine a power outlet with a microscope much less teach, suggest or motivate one to create a microscope comprising an outlet for accepting a power cord wherein the outlet includes a safety cover that is adapted to be removed by a service technician and not by an end user.

Hence, for the reasons set forth above, Applicants respectfully submit aht the invention of Claims 1-8 is nonobvious in view of Kraft et al. and Austin.

Conclusion

For the reasons set forth above, Applicant respectfully submits that all pending claims are now in condition for allowance, which action is courteously requested.

Respectfully submitted,



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